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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Alex TAYLOR et al.

Group Art Unit: 2176

Application No.: 09/981,835

Examiner: L. RIES

Filed: October 19, 2001

Docket No.: 110914

For: METHOD AND APPARATUS FOR FORWARD ANNOTATING DOCUMENTS

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The following remarks are directed to the new points of argument raised in the Examiner's Answers dated August 23, 2006 and September 29, 2006.

The Examiner's Answer maintains the rejection of pending claims 1-7, 9-16, 18 and 19 under 35 U.S.C. §103(a) over Price et al., *Linking by Inking: Trailblazing in a Paper-Like Hypertext* (hereinafter "Price") in view of Golovchinski et al., *From Reading to Retrieval: Freeform Ink Annotations as Queries* (hereinafter "Golovchinski") and further in view of Lawton et al., *The Knowledge Weasel Hypermedia Annotation System* (hereinafter "Lawton").

Modifying the system and method of Price by incorporating the teachings of Lawton would render the system and method of Price unsuitable for their intended purpose as well as change their principle of operation. If Price were modified by the alleged teaching of Lawton to pre-select target documents before the source document is annotated, then both the query

creation function and subsequent document search function of Price would be unnecessary. That is, there would be no reason to create a query for a search, as the target documents would already be known. Thus, the Patent Office fails to consider each reference as a whole, but instead improperly selects features from each reference using Applicants' claims as a template. There is no motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to combine the reference teachings to obtain the combinations of features recited in independent claims 1, 9 and 19. The Patent Office relies on impermissible hindsight.

The Examiner argues, on pages 11 and 12 of the Examiner's Answer regarding claims 1, 9 and 19, that the Final Rejection's proposed modification of Price would not render the system/method of Price unsuitable for its intended purpose because "there is no reason to omit the possibility that the data source from which these documents are selected is a finite collection of documents," and because Lawton allegedly also teaches that target documents may be obtained via search techniques from a finite set of documents. However, this allegation still fails to overcome the above-described deficiencies of the §103(a) rejection.

If the Examiner is using the phrase "finite collection of documents" to mean a collection of documents from which the target documents are subsequently selected, the deficiencies of the §103(a) rejection are not remedied. In this case, although the collection of documents (i.e., the database) that will be searched by the modified system and method of Price may be known to the user, the actual target documents which would be returned as a result of the search would not be known to the user. That is, the target documents would not be "pre-selected from the database as the...target document by a user of the system before the source document is annotated" (emphasis added), as recited in pending claims 1 and 9, and similarly required by claim 19. This is because, according to Price, the target documents

would only be selected as a result of the search, which occurs as a result of and after the annotation of the source document.

The deficiencies of the §103(a) rejection also are not remedied if the Examiner is using the phrase "finite collection of documents" to mean a collection of target documents, each of which will be annotated. The target documents would be known to the user. Thus, there would be no reason to create a query for a search, as the target documents would already be known and would not need to be searched for. Similarly, there would be no reason to search for documents based on the query if the target document is already pre-selected and known to the system.

The Examiner's example on page 13 of the Examiner's Answer, allegedly supporting the need for a query when a target document is pre-selected and known to the system if it exists within a finite collection of documents, is not applicable to the claimed features. In the Examiner's example, although a user may search for patents included in a finite set of patent documents, the database of patent documents is pre-selected by the Patent Office, not the user, as recited in claims 1 and 9, and similarly required by claim 19.

The Examiner argues, on page 12 of the Examiner's Answer, that the Final Rejection's proposed modification of Price would not render the system/method of Price unsuitable for its intended purpose because Price's discussion of "serendipity" (see page 33, col. 2) is merely one example of various uses proposed by Price. In support of its assertion, the Examiner contradicts her earlier interpretation of Price by stating that "there is no reason to infer by the teachings of Price that the collection of documents read and browsed may be limited to a finite collection of pre-selected documents" (emphasis added). If Price is interpreted to not disclose a finite collection of pre-selected documents, then none of the Examiner's above

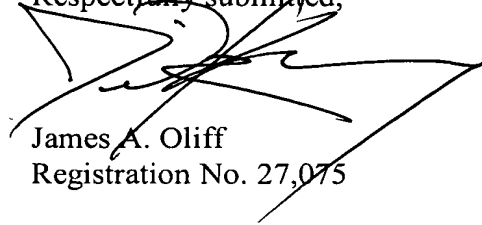
allegations, based on the alleged possibility that the data source in Price from which documents are selected is a finite collection, are applicable.

Although the Examiner asserts that discussion of "serendipity" in Price is merely an example of various uses, Price does not disclose or suggest otherwise. Further, the Examiner has failed to identify another example other than merely repeating that "XLibris supports reading and browsing over a wide variety of documents" (see page 33, col. 1).

Accordingly, the Patent Office fails to provide any suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. Because there is no motivation to modify Price as proposed by the Patent Office, the Patent Office has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claims 1-7, 9-16, 18, and 19 under 35 U.S.C. §103(a) over Price in view of Golovchinski and further in view of Lawton is improper.

The Honorable Board is requested to reverse the rejections set forth in the Final  
Rejection and direct the Examiner to pass this application to issue.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

David R. Kemeny  
Registration No. 57,241

JAO:DRK/kxs

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**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

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